

Appl. No.: 09/745,290
Filed: December 20, 2000
Amdt. dated 10/26/2005

REMARKS

This amendment is submitted in response to the Office Action dated July 26, 2005. Claims 1-52 currently stand rejected. Claims 41 and 51 have been canceled. Applicants have amended independent claims 1, 26, 27, 28, 33 and 43 in order to further patentably distinguish these independent claims and their corresponding dependent claims from the cited references. Claims 25, 40, 42, 50 and 52 have been amended to ensure proper correlation with corresponding ones of the amended independent claims. New claims 53 and 54 have also been added to further define particular aspects of the claimed invention. No new matter has been added by the amendment.

In light of the amendment and the remarks presented below, Applicants respectfully request reconsideration and allowance of all now-pending claims of the present application.

I. Claim Rejections Under 35 U.S.C. §102(e)

Claims 1-24, 26-39 and 43-49 were rejected under 35 U.S.C. §102(e) as being anticipated by Tso et al., (U.S. Patent No. 6,421,733, hereinafter "Tso").

Applicant has amended independent claim 1 to recite, *inter alia*, segmenting the digital document into subdocuments, and transmitting fewer than all of the subdocuments over the communication channel in response to the request, wherein at least one of the subdocuments transmitted includes a link to an adjacent subdocument. In other words, a document is segmented into multiple subdocuments, some of which contain links to adjacent subdocuments.

As conceded by the Office Action in conjunction with claim 25 which previously included the above recitation, Tso fails to teach or suggest the above claimed features. Accordingly, independent claim 1 is patentably distinct and nonobvious in view of Tso. Independent claims 26, 27, 28, 33 and 43 have been amended to incorporate similar recitations to those of independent claim 1 with respect to subdocuments and associated links to adjacent subdocuments. Thus, independent claims 26, 27, 28, 33 and 43 are patentable for at least those reasons given above for independent claim 1. Claims 2-24, 29-32, 34-39 and 44-49 depend either directly or indirectly from corresponding ones of independent claims 1, 26, 27, 28, 33 and 43, and thus include all the recitations of their corresponding independent claims. Therefore,

Appl. No.: 09/745,290
Filed: December 20, 2000
Amdt. dated 10/26/2005

dependent claims 2-24, 29-32, 34-39 and 44-49 are patentable for at least the reasons given above for independent claims 1, 26, 27, 28, 33 and 43.

Accordingly, for all the reasons stated above, Applicants respectfully submit that the rejections of claims 1-24, 26-39 and 43-49 under 35 U.S.C. §102(e) are overcome.

II. Claim Rejections - 35 USC §103

Claims 25, 40-42 and 50-52 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Tso in view of Tsimelzon et al. (U.S. Patent No. 6,763,388, hereinafter "Tsimelzon"). Claims 41 and 51 have been canceled, thus the rejections of claims 41 and 51 are now moot. It is submitted that the cited references fail to render the claimed invention obvious because the cited references fail to teach or suggest the recitations of the claimed invention. Furthermore, even assuming the cited references teach or suggest the recitations of the claimed invention, there is no motivation to combine the cited references.

A. The cited references fail to teach or suggest the claimed invention.

As stated above and in the Office Action, Tso fails to teach or suggest that at least one of the subdocuments transmitted includes a link to an adjacent subdocument as claimed in independent claims 1, 33 and 43. In particular, Tso discloses a system for dynamically transcoding data transmitted between computers via a transcoder (20) (col. 2, lines 44-49). The transcoder (20) includes a parser (22) and a plurality of transcode service providers (24) (col. 3, lines 8-10). The parser (22) selectively invokes one or more transcode service providers (24) based upon predetermined selection criterion (col. 3, lines 13-16). As such, the transcode service providers (24) may compress or scale data content (col. 3, lines 51-54). Thus, the transcoder (20) of Tso transcodes entire documents such that a received document is revised and transmitted as an entire revised document. Accordingly, there is no teaching or suggestion in Tso of subdocuments. Furthermore, since there is no disclosure in Tso with respect to subdocuments, there can be no disclosure regarding a subdocument including links to an adjacent subdocument. Thus, Tso fails to teach or suggest at least one of the subdocuments transmitted includes a link to an adjacent subdocument.

Appl. No.: 09/745,290
Filed: December 20, 2000
Amdt. dated 10/26/2005

Tsimelzon is directed to a method and apparatus for selecting and viewing portions of web pages. Tsimelzon discloses "web clipping" in which a link to the user's startpage is created and downloaded into the user's handheld device (col. 10, lines 47-49). Using the web clipping function, a user may select a link from the startpage to the shortpage to permit the user to access a stored shortpage from the startpage. Tsimelzon discloses additional links as well. For example, a link to the startpage page (col. 9, line 17), a link to a notification page (col. 9, line 18), a link to a help page (col. 9, line 18), a link to edit a shortpage (col. 9, line 19), and a link to a full page upon which the shortpage is based (col. 9, lines 20-21). However, none of the links disclosed in Tsimelzon is a link in a subdocument to an adjacent subdocument as claimed in independent claims 1, 33 and 43. Furthermore, Tsimelzon fails to teach any link to a subdocument, since a shortpage is a collection of webpage elements and thus, not analogous to a subdocument.

Since Tso and Tsimelzon each fail to teach or suggest the aforementioned features of independent claims 1, 33 and 43, any combination of Tso and Tsimelzon also fails to teach or suggest the subject matter of independent claims 1, 33 and 43. Thus, Tso and Tsimelzon, taken either individually or in combination, do not anticipate, or render independent claims 1, 33 and 43 obvious. Claims 25, 40, 42, 50 and 52 depend either directly or indirectly from a respective one of independent claims 1, 33 and 43, and as such, include all the recitations of their respective independent claims. The dependent claims 25, 40, 42, 50 and 52 are therefore patentably distinct from the cited references, individually or in combination, for at least the same reasons as given above for independent claims 1, 33 and 43.

B. No motivation to combine references.

Even assuming for arguments sake that the cited references teach or suggest each of the elements of the claimed invention as recited in the independent claims (an assumption with which Applicants expressly disagree), Applicants submit that one skilled in the art would not be motivated to combine Tso with Tsimelzon to disclose the claimed invention and any such motivation can only be found from the Applicants' disclosure of the present application. In order to properly combine references, a teaching or motivation to combine the references is essential.

Appl. No.: 09/745,290
Filed: December 20, 2000
Amdt. dated 10/26/2005

In re Fine, 837 F.2d 1071, 1075 (Fed. Cir. 1988). In fact, the Court of Appeals for the Federal Circuit has stated that “[c]ombining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure of a blueprint for piecing together the prior art to defeat patentability -- the essence of hindsight.” *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Although the evidence of a suggestion, teaching or motivation to combine the references commonly comes from the prior art references themselves, the suggestion, teaching or motivation can come from the knowledge of one of ordinary skill in the art or the nature of the problem to be solved. *Id.* In any event, the showing must be clear and particular and “[b]road conclusory statements regarding the teaching effort of multiple references, standing alone, are not ‘evidence’.” *Id.*

In this situation, as stated above, Tso is directed to dynamically transcoding data transmitted between computers via a transcoder. As such, the transcoder of Tso transcodes entire documents such that a received document is revised and transmitted as an entire revised document. Tso fails to suggest that such transcoding might be enhanced by segmentation of the received document. Meanwhile, Tsimelzon is directed to a method and apparatus for selecting and viewing portions of web pages. Tsimelzon discloses two primary embodiments. First, Tsimelzon discloses that a user may select sub-elements of a web page to be displayed on a shortpage which is revised with respect to the web page such that the shortpage includes less than all the elements of the web page (col. 3, line 66 to col. 4, line 7). Thus, the shortpage is transmitted for display and includes a collection of the user selected sub-elements. Second, Tsimelzon discloses dividing a webpage into a plurality of blocks (FIGS. 5 and 6), with each block having selection enabling information (col. 7, lines 6-9). The web page is displayed along with the selection-enabling information for each block (col. 8, lines 2-4). Responsive to selection of particular blocks, a shortpage is generated including the selected blocks (abstract). Accordingly, Tsimelzon discloses either receiving a full page divided into blocks, or receiving a shortpage including a collection of elements selected from the full page. One of skill in the art, seeking to improve the transcoding features of Tso would not find motivation to do so in the cited references. Tso discloses that transcoding may include adding, modifying, or deleting data (col. 2, lines 47-49). Thus, it is submitted that a person skilled in the art would not have been

Appl. No.: 09/745,290
Filed: December 20, 2000
Amdt. dated 10/26/2005

motivated by Tso or otherwise to have deployed the web page dividing method described by Tsimelzon in a manner so as to segment a document into a revised document including subdocuments, as recited by amended independent claims 1, 33 and 43. Instead, it is submitted that a person skilled in the art would have only been motivated to such improvement by hindsight in view of the present application.

Thus, Applicants submit that no proper combination of the cited references teaches or suggests the method, network entity or computer program product as recited by amended independent claims 1, 33 and 43. As the dependent claims 25, 40, 42, 50 and 52 include the recitations of independent claims 1, 33 and 43, the dependent claims are also not taught or suggested by any proper combination of the cited references for at least the same reasons as described above in conjunction with independent claims 1, 33 and 43. For the foregoing reasons, it is therefore submitted that the rejection of dependent claims 25, 40, 42, 50 and 52 are overcome.

C. Conclusion

In summary, the cited references fail to teach or suggest the claimed invention. However, even assuming for the sake of argument that the cited references teach or suggest the claimed invention (an assumption with which the Applicants expressly disagree), there is no motivation to combine the cited references.

Accordingly, for all the reasons stated above, Applicants respectfully submit that the rejections of claims 25, 40, 42, 50 and 52 under 35 U.S.C. §103(a) are overcome.

III. Newly Added Claims

Applicant has added new claims 53 and 54 to more particularly define aspects of the claimed invention. The newly added claims recite additional features that are patentably distinct over the cited references. However, the newly added claims are at least patentable due to their dependency on independent claim 1, which is patentable for reasons argued above. The new claims include no new matter and are fully supported by the specification and the drawings of the present application.

Accordingly, it is believed that the new claims are in condition for allowance.

Appl. No.: 09/745,290
Filed: December 20, 2000
Amdt. dated 10/26/2005

CONCLUSION

In view of the amended claims, the new claims and the remarks presented above, it is respectfully submitted that all of the claims are in condition for allowance. Accordingly, a Notice of Allowance is respectfully requested in due course. The Examiner is encouraged to contact Applicants' undersigned attorney to resolve any remaining issues in order to expedite examination of the present application.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

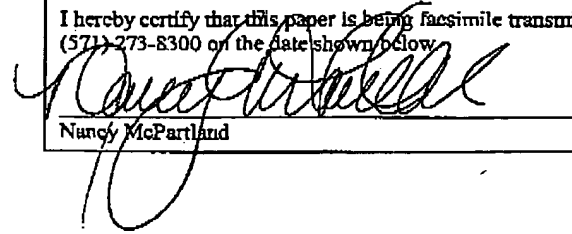


Chad L. Thorson
Registration No. 55,675

Customer No. 00826
ALSTON & BIRD LLP
Bank of America Plaza
101 South Tryon Street, Suite 4000
Charlotte, NC 28280-4000
Tel Charlotte Office (704) 444-1000
Fax Charlotte Office (704) 444-1111

CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being facsimile transmitted to the US Patent and Trademark Office at Fax No. (571) 273-8300 on the date shown below.



Nancy McPartland

Date

10-26-05